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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/898,152	07/03/2001	Michael Wen-Chein Yang	POLY-1193	7052

7590

10/08/2004

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EXAMINER

HAMILTON, CYNTHIA

ART UNIT

PAPER NUMBER

1752

DATE MAILED: 10/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No. 09/898,152	Applicant(s) YANG ET AL.	
	Examiner Cynthia Hamilton	Art Unit 1752	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Attachment.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Attachment.
6. ☒ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 30-39,42,44,45,50 and 51.

Claim(s) objected to: _____.

Claim(s) rejected: 15,17-20,22,26,27,46-49 and 52.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Cynthia Hamilton
Primary Examiner
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ATTACHMENT

Benefit of filing date of prior applications Issue

1. Applicants have failed to comply with one or more conditions for receiving the benefit of an earlier filing date under 35 USC 120 by referencing the amendment of August 89, 2001. With respect to applicant's allegation of "timely filing" a correct benefit claim in this application as of August 8, 2001, the following chronology is noted:

- a. At the time of filing the instant application, applicants struck the first paragraph of page 1 of the instant specification which was as follows:

Related Applications

This application is a continuation-in-part of our copending application United States Serial No. 082,689 filed June 23, 1993, entitled LASER IMAGED PRINTING PLATES, incorporated herein by reference.

and replaced at time of filing this paragraph with the following paragraph in a Preliminary amendment that was part of the Patent Application Transmittal Letter (TRNA in IFW with date of 07/03/2001) as follows:



Please enter the following amendment to the Specification under the Cross-Reference to Related Applications section (or create such a section): "This Application:

☐ is a continuation of ☒ is a divisional of Application Serial No. 08/905,654 filed 8/4/97, which is a file wrapper continuation of 08/479,337 filed 6/7/95 which is a continuation in part of 08/082,689 filed 6/25/93, the contents of each of which are hereby included by reference in their entity.

Thus, applicants at this point appeared to err with respect to the Serial number of 08/479,337 which has no inventors in common with the other applications. Applicants also did not make a proper incorporation by reference statement at this time either, i.e. "the contents of each of which are hereby included by reference in their entity." This

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amendment at time of filing governs what was part of the originally filed application.

Mere reference to another application, patent, or publication is not an incorporation of anything therein into the application containing such reference for the purpose of the disclosure required by 35 U.S.C. 112, first paragraph. In re de Seversky, 474 F.2d 671, 177 USPQ 144 (CCPA 1973). This is the continuity now of record in the USPTO Palm system.

b. On August 13, 2001, applicants amended the specification (in IFW this amendment to the specification is found under CLM dated 08/13/2001) as follows:

POLY-1193	PATENT
--This application is a division of U.S. application Serial No. 08/905,654, filed on August 4, 1997, which is a division of U.S. application Serial No. 08/479,339, filed on June 7, 1995, which is a continuation-in-part of U.S. application Serial No. 08/082,689, filed on June 25, 1993. The respective disclosures of each of these patent applications is incorporated herein by reference.--	

At this time, applicants submit (1) incorporation by reference to three applications, (2) the first listing of US application Serial No. 08/479,339 (which is correctly a continuation-in-part of US application Serial No. 08/082,689), (3) listed US application serial No. 09/905, 654 as a "division" of U.S. application Serial No. 08/479,339 and (4) did not as far as the examiner can determine request a corrected filing receipt for the changes in continuity. The clerical staff entered this amendment but no change to the continuity was made in PALM. The examiner notes for the record that US application serial No. 09/905, 654 is not a division of U.S. application Serial No. 08/479,339 but instead is a continuation, via a file wrapper, of U.S. application Serial No. 08/479,339. Thus, the amendment filed August 13, 2001 while correcting the Serial No. 08/479,337

to 08/479,339 introduced a new error with regard to the status of 08/479,339 with respect to the benefit claim.

c. On March 20, 2003, an OG notice set forth the requirements to obtain prior filed application.

d. Previous to the OG notice of March 20, 2003, the examiner had repeatedly discussed with her SPE (until September 2003), Janet Baxter, if the "incorporation by reference" to a continuation or division was proper because one was supposed to be like the other with regard to the disclosure. The conclusion had been that incorporation at that point was allowable because of the "division" or "continuation" status. With the OG Notice publication, the USPTO made clear that such incorporation was not allowable if not part of the original filing for application.

e. In the Office Action mailed November 6, 2003 which is the first action in the instant application after the March 20, 2003 OG notice, the examiner makes first note that the continuity of record is incorrect but notes the amendment of July 3, 2001 and the incorrect Serial No. 08/479,337, but does not note the amendment to the specification of August 12, 2002. The examiner notes also this is the first action in this application which was done under the Image File Wrapper system.

f. In reply received March 9, 2004, applicants amend the specification on page 1, the first paragraph, as follows:

This Application is a divisional of Application Serial No. 08/905,654 filed 8/4/97, which is a file wrapper continuation of 08/479,339 ~~08/479,337~~ filed 6/7/95 which is a continuation in part of 08/082,689 filed 6/25/93, the contents of each of which are hereby incorporated ~~included~~ by reference in their entirety.

This appears to be the first supportable request of Benefit claims all the way back to 1993 with both correct relationship between applications and correct application numbers submitted by applicants in the instant application. The incorporation reference however is still present but unacceptable under the guidelines set forth on March 20, 2003 in the OG notice. This "incorporation" should have been addressed as an addition of new matter to the specification at the time it was presented.

g. In the Final rejection mailed April 13, 2004, the examiner warned applicants that the benefit claim of March 9, 2004 was not entered because it was not accompanied by a petition for unintentional delay. The portion of interest is given below:

1. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

Applicants' failure to present a petition to accept an unintentionally delayed claim for priority under 35 U.S.C. 120 and 121 as required under 37 CFR 1.78 (A)(2) with respect to the addition of SN: 08/479,399

2. The benefit claim filed on March 9, 2004 was not entered because the required reference was not timely filed within the time period set forth in 37 CFR 1.78(a)(2) or (a)(5). If the application is an application filed under 35 U.S.C. 111(a) on or after November 29, 2000, the reference to the prior application must be submitted during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. If the application is a nonprovisional application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the reference to the prior application must be made during the pendency of the application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). If applicant desires priority under 35 U.S.C. 120 and 35 USC 121 based upon a previously filed applications, applicant must file a petition for an unintentionally delayed benefit claim under 37 CFR 1.78(a)(3) or (a)(6). The petition must be accompanied by: (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted); (2) a surcharge under 37 CFR 1.17(t); and (3) a statement that the entire delay

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between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

3. The Effective filing date of this application remains August 4, 1997, which is the filing date of 08/905,654. Because a granted petition of unintentional delay in adding SN 08/479,339 to the list of parent applications is not of record in this application the date of June 7, 1995 or June 25, 1993 of 08/082,689 is not granted.

h. In an applicant initiated interview of August 25, 2004, applicant's representative brought up the presence of the August 13, 2001 amendment as evidence that they had amended the benefit claim correctly within the required time of filing thus avoiding the need for a petition now for unintentional delay. The examiner at that time agreed the amendment looked as though it did meet the necessary conditions, but questioned the insertion of "incorporated herein by reference" as a possible issue. She did note that if rejections had to be made because she had not fully considered all the papers submitted before final rejection that the finality of the last Office Action would have to be removed.

i. On September 9, 2004 applicants submitted their Amendment Under 37 CFR 1.116, i.e. after final amendment along with :

In reviewing the application file, Applicants determined that the benefit claim to priority was timely filed within the time period because it was submitted in a preliminary amendment deposited on August 8, 2001, which is within four months of the actual filing date of the application (July 3, 2001). Applicants' representative contacted the Examiner and explained that the benefit claim to priority was timely filed within the time period. In the Telephone Interview held with the Examiner on August 24, 2004, and in the Examiner's Interview Summary, the Examiner agreed that the correction was done in a timely fashion as required by 37 CFR 1.78(a)(2). Therefore, it is Applicants' belief that the effective filing date of this application is June 25, 1993 because priority was timely filed within the required time period.

and with respect to the incorporation by reference claim the following:

Applicants believe that the incorporation by reference phrase does not constitute new matter. The incorporation by reference phrase was present in the originally filed application papers in the Patent Application Transmittal Letter, page 3, which incorporated the contents of each of the related applications by reference in their entirety. While the 08/479,339 application was incorrectly referred to as the 08/479,337 application, this error was timely corrected within the appropriate time period as discussed above. Therefore, Applicants respectfully submit that because the incorporation phrase was present in the preliminary amendment filed concurrently with the present application and the cross-reference to related applications was only amended to correct the typographical error in the application number for the 08/479,339 application, that the incorporation by reference phrase does not constitute new matter as it was present in the application as filed.

Applicant's representative gave the examiner permission to cancel the incorporation reference if it were all that remained with respect to allowance of the instant application as follows:

However, if the Examiner determines that the incorporation by reference phrase does constitute new matter notwithstanding the above arguments presented by Applicants, and further, if all other issues in the application are resolved, permission is given to the Examiner to correct the cross-reference to related applications section and remove the incorporation by reference phrase in an Examiner's Amendment.

Applicants in their remarks continued to refer to SN 08/905,654 as a division of SN 08/479,339 as evidenced by the following excerpt from page 10 of their submission:

application. The 08/479,339 application, which is a continuation-in-part of the 08/082,689 application, contains the same disclosure as 08/905,654 which is a division of the 08/479,339 application and the instant application, which is a division of the 08/905,654 application. The continuation-in-part application provides a substantially

j. Upon receiving the amendment of September 9, 2004, the examiner reviewed the entire file with respect to the issue of amendments and benefit status of parent applications. This is when she discovered the incorrect relationship in the Amendment of August 13, 2001 with respect to 08/905,654 being referenced as a division of 08/479,339 instead of the actual relationship of 08/905,654 as a continuation of 08/479,339. Thus, the Amendment of August 13, 2001 is not in correct form to obtain benefit of the filing date beyond that of 08/905,654 if a corrected filing receipt had been issued. The amendment of August 13, 2001 was replaced by the amendment to the specification of March 9, 2004. The specification now reads as amended on March 9, 2004 with regard to the first paragraph of page 1 which again is as follows:

This Application is a divisional of Application Serial No. 08/905,654 filed 8/4/97, which is a file wrapper continuation of 08/479,339 ~~08/479,337~~ filed 6/7/95 which is a continuation in part of 08/082,689 filed 6/25/93, the contents of each of which are hereby incorporated ~~included~~ by reference in their entirety.

The examiner notes that applicants have failed to show in the request for reconsideration filed September 24, 2004 that the August 13, 2004 amendment corrected the benefit claim to prior Applications 08/479,339 and 08/082,689 for the reasons given above.

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2. If applicants pursue further prosecution of this application, the examiner will issue an objection to the specification under 35 U.S.C. 132 because the incorporation by reference introduces new matter into the disclosure with respect to the March 9, 2004 amendment to the specification.

3. The Kanga Declaration submitted on September 21, 2004 is not a copy of the Declaration filed March 9, 2004 or August 12, 2003. Since applicants submitted a newly executed Declaration as evidenced by the dated signature of September 21, 2004, the examiner checked the Declaration to determine if the only changes were to the reference to the Exhibit pages that had been the reason for refiling the Declaration. She found the Declaration was changed in other ways than reference to the Exhibit pages. One such change was on page 6 last four lines, is an example of a change in wording by replacing "photopolymerizable" with "photocurable".

Because of this change, the examiner considers the new Declaration not to address issues solely brought upon in the final rejection. The Declaration is not signed by all of the inventors nor is it presented as a 37 CFR 1.131 Declaration thus it cannot be used to antedate the Fan reference.

The Declaration must then be considered to have been filed under 37 CFR 1.132. Since the effective filing date of the instant application is not June 1993, evidence showing the support in US application Serial No. 08/082,689 is found for claims in another application, i.e. patent application Serial No. 09/921,589 as declared by Dr. Kanga in the fifth point of the Declaration is not relevant the rejection at hand.

4. The amendment to the claims is denied entry because the Declaration is left unconsidered thus, the Amendment cannot be entered in part. The amendment to the claims also does not make

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the application clearly allowable in view of the issue of benefit of filing date from the prior applications still in question.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cynthia Hamilton whose telephone number is 571-272-1331. The examiner can normally be reached on Monday through Friday 9:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H Kelly can be reached on (571) 272-0729. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

October 5, 2004



CYNTHIA HAMILTON
PRIMARY EXAMINER

Cynthia Hamilton
Primary Examiner
Art Unit 1752